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BEFORE THE BOARD OF APPEALS AND INTERFERENCES
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Terry et al.

Serial No. 09/365,349

Filed: July 30, 1999

For: *Heavy Metal Phytoremediation*

Group Art Unit: 1638

Examiner: Ibrahim, M.

Attorney Docket No. B99-085

CERTIFICATE OF MAILING
I hereby certify that this corr is being deposited with the US Postal Service as First Class Mail in an envelope addressed to the Comm of Patents, Washington, D.C. 20231 on August 16, 2001

Signed _____
Richard Osman

REPLY BRIEF ON APPEAL

The Commissioner of Patents
Washington, D.C. 20231

Dear Commissioner:

The following remarks are limited to addressing new issues raised in the Examiner's Answer. As a contextual matter though, we note that this Examiner forced us to appeal rejections of these claims under 35USC102(a) and 35USC103(a). Instead of answering our first Brief, she withdrew all her rejections and applied new rejections under 35USC112, first paragraph (written description), and 35USC112, first paragraph (enablement). Without amending our claims, we immediately appealed these new rejections. Now she has withdrawn all her written description rejections, and has withdrawn her enablement rejection as to claims 4, 9-12, 16-18, 21 and 23-24.

Status of Amendments

The Answer acknowledges that the proposed Examiner's Amendment of Sept 19, 2000 was offered to accelerate the prompt issuance of a valid patent. But this Amendment merely inserted –Brassica– before "plant" in pending claim 1 – which yields exactly the invention of pending claim 3. Either the present rejections have or do not have merit. The Examiner has no discretion to withdraw a meritorious rejection. Her offer to allow "valid" claims with the same limitations can only be construed to mean that the pending rejections were deemed by the

Examiner to be without merit. What she did was try to leverage rejections she considered meritless to extract from Applicants a limitation on the recited plant. The imposition of those rejections now is making good on her threat. That is extortion. Our remarks are not discourteous, but accurately report this Examiner's conduct.

Grouping of the Claims

The Answer's disagreement with our grouping of the claims appears to reflect a misapprehension of the purpose of our discretionary grouping of the claims.

Enablement

We rely on our arguments of record. We note only that the Examiner's reliance on the so-called "unpredictability provided by the scientific publications" is premised on (1) her confusing tolerance and accumulation, and we again refer her to our remarks of record, most recently reiterated in our Supplemental Appeal Brief on p.7, line 6 - p.8, line 18; and (2) her misreliance on Noctor et al. Noctor et al. did not have the benefit of our Specification, which teaches how to make the claimed hyper-accumulating plants, including hyper-accumulating poplars. Noctor et al reports that in unpublished "preliminary experiments" they failed to obtain hyper-accumulating poplars. We do not know how Noctor et al. did their experiments, so it is not possible for us to determine why they failed: we do not know in what form they provided the Cd, we do not know whether their poplars were subject to other variables that would have interfered with accumulation, we do not know how they made their transformants, we do not know whether their preliminary experiments were based on one or two anomalous plants, we do not know if their soil had other toxins or confounding microorganisms that may have independently depleted the supplemented Cd, etc. It is possible that the results of Noctor et al. are based on experimental error or contaminated materials. On the other hand, it is possible that they result merely from an insufficient sample size – had they generated sufficient data, they may well have obtained hyper-accumulators. Unless she has secret information about Noctor et al.'s work, the Examiner's proposed "only reasonable explanation" (Answer, p.11, line 14) for Appellant's success does not reflect even a basic understanding of the scientific methodology. Furthermore, even had Noctor et al. had the benefit of, and followed our teachings, their reported failure would not be inconsistent with our enabling disclosure. Like *Wands*, we do not promise

that every single attempt will result in a successful, hyper-accumulating plant. Just like immunologists making monoclonal antibodies, plant bioengineers expect to make a sufficient panel of transformants and then select for the desired phenotype. There is no evidence that Noctor et al. made such a panel; in fact, that Noctor et al. did not publish their data, but rather merely refer to unpublished "preliminary experiments" in a review article suggests they did not.

Finally, we note that the Examiner has indicated the subject matter of claim 4 et al. are now deemed allowable. Claim 4 merely limits claim 1 to a particular plant species. Hence, the Examiner has withdrawn all appealed-from rejections relating to the nature of the ECS gene, the promoter, the heavy metal, etc. (10/24/00 Action, p.3, lines 12-16), and the subject enablement rejection is limited to the nature of the recited plant. Similarly, the now deemed allowable method claims 16-18 and 23-24 do not further limit the recited medium. Hence, the Examiner has withdrawn the appealed-from rejections relating to the scope of the recited medium (10/24/00 Action, p.3, line 14), and her persisting arguments (Answer, p.12, lines 7-17; p.15, lines 15-19) are now moot.

The pending rejection is without merit or support. It also reflects an abuse of administrative process. Appellants respectfully request reversal of the pending Final Action by the Board of Appeals.

Appellants hereby petition for any necessary extension of time pursuant to 37 CFR 1.136(a). The Commissioner is hereby authorized to charge any necessary fees (small entity) or credit any overcharges associated with this communication to our Deposit Account No. 19-0750 (order no.B99-085).

Respectfully submitted,
SCIENCE & TECHNOLOGY LAW GROUP

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